

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-10 are currently pending in the application, with claims 1, 5, 8, 9 and 10 being the independent claims. Claims 1, 4, 7-10 have been amended. Claims 11-17 have been added. No new matter has been added. Based on the amendments above and the following remarks, Applicants respectfully request that the claims be passed to allowance.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Rejection of Claims 4 and 10 under 35 U.S.C. § 112

The Examiner has rejected claims 4 and 10 under 35 U.S.C. § 112, second paragraph. Applicants have amended claim 4 and 10 to accommodate the Examiner's rejection. The amendments are not intended to narrow the scope of protection. Applicants respectfully request that the rejection be withdrawn.

II. Rejection of Claims 1-9 under 35 U.S.C. § 102

The Examiner has rejected claims 1-9 under 35 U.S.C. § 102 as being unpatentable over U.S. Patent No. 5,699,528 to Hogan ("the Hogan patent). Applicants respectfully traverse this rejection.

Hogan describes a technique for delivery of bills over a communication network, and payment of bills through the network using a personal computer. Hogan, col. 3, lines 47-50. A subscriber's personal data, including address and e-mail, are stored. Col. 5, lines 22-36. Subscriber's can access a bill via the Internet, and pay the bill using one

or more accounts. Col. 5, lines 1-5. The customer can view full graphics of the bills, print the bills, and download the bill for storage. Col. 5, lines 6-9.

Applicants' claimed invention is directed to allowing a party to send an electronic mail message (e-mail) using the physical address of a recipient instead of his/her e-mail address (which may be unknown). This is clearly not disclosed in Hogan.

Amended independent claim 1 recites "a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server including means for mapping a physical address to an e-mail address upon receipt of an e-mail from a party." Applicants have amended claim 1 to more particularly point out the invention, but not to overcome the prior art rejection. Hogan only discloses associating a physical address and an e-mail with a subscriber. Hogan does not disclose "a mapping from a physical address to an e-mail address" as recited in un-amended independent claim 1. It is therefore further argued that Hogan does not disclose mapping from a physical address to an e-mail address upon receipt of an e-mail from a party. Accordingly, Applicants respectfully request that the rejection be withdrawn, and that claims 1-4 be passed to allowance.

The two steps recited in independent claim 5 are not disclosed in Hogan. The Examiner has merely made a blanket rejection stating "one using the device of Hogan would have performed the same steps set forth in claim 1-8." Office Action, page 3. Applicants respectfully disagree. Hogan does not disclose "allowing a user to specify a physical address of a recipient to whom [an] e-mail is to be sent" nor does Hogan disclose "performing a mapping function on a server, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient." Further,

dependent claim 6 recites "routing an e-mail to a printer where the e-mail is printed and delivered via traditional mail delivery means." Hogan does not disclose printing an e-mail and delivering it via traditional mail. Still further, amended dependent claim 7 states that the e-mail is associated with one of a plurality of classes. This is also not taught by Hogan. Accordingly, Applicants respectfully request that the rejection be withdrawn, and that claims 5-7 be passed to allowance.

Amended independent claims 8 and 9 are patentable for the same reasons provided above in regard to claims 1-7. Applicants have amended these claims to more particularly point out the invention and not to overcome the prior art of record. Further, Applicants take issue with the Examiner's statement that "every mail server includes a so-called 'designator' to sort e-mails." Applicants respectfully request that the Examiner provide evidence to support this statement since Applicants do not believe that every mail server divides e-mails into classes as recited in independent claim 9. Accordingly, Applicants respectfully request that the rejection be withdrawn, and that claims 8-9 be passed to allowance.

III. Rejection of Claim 10 under 35 U.S.C. § 103

The Examiner has rejected claim 10 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,015,167 to Savino et al. ("the Savino patent"). Applicants respectfully traverse.

As discussed above with reference to claims 1-9, Applicants' invention allows a physical address of a recipient to be used to send an e-mail. Amended independent claim 10 clearly recites this feature of Applicants' invention. The Savino patent fails to teach

or suggest this feature. Accordingly, Applicants respectfully request that the rejection be withdrawn and that claim 10 be passed to allowance.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert Sokohl
Attorney for Applicants
Registration No. 36,013

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600